

REMARKS

The claims pending presently in this case are 29, 33, 35-39, 43, and 45-48, all of which were previously presented. The original forms of these claims were copied from U.S. Patent No. 5,790,636, to Marshall, issued on August 4, 1998 (hereafter the '636 Patent). The claims were amended from their original scope by the last amendment.

The claims were rejected under 35 U.S.C. 112, paragraph 1. Although the prosecution has addressed such rejections before, some further points are appropriate. To that end, Applicant incorporates by reference the arguments and positions previously asserted, though not repeated here.

Preliminarily, it is deemed appropriate to consider briefly the '636 Patent from which the claims here are derived. Note, for example, that Claim 1 of the '636 Patent does not recite either originating or destination telephone terminals. Specifically, the '636 Patent does not show a single receiving terminal. Each of the illustrated terminals (left of the Figure) are originating terminals and involve possible initial connections to any of several components as stated below (See Col. 4, Lines 1-16). Specifically, the connections are:

- a. Pay phone 12 connects to switch processor 18.
- b. Touch tone phone 68 connects to voice response 66.
- c. Cellular phone 66 connects to cellular network entity 58.
- d. Telephone remote 50 connects to data storage server 42.

From such initial connections, the Digital Central Office (DCO) switch may allow a call to proceed "*in the usual course*" (see col. 5, line 18).

If the processing of a call is favorable, the DCO switch 22 variously allows completion of the call in accordance with the customer's requirements (see col. 7, lines 39-41). In the example

of a card-supported call, the call is presumably completed to a call terminal as dialed, however, other possibilities exist (see col. 3, lines 23-27). Specifically, as alternative examples, the call may be re-routed to a home office or to a voice response unit.

The significant point relating to the above description is the fact that neither claim 1 of the '636 Patent nor the disclosed embodiment of the '636 Patent is limited to credit calls from an originating to a called terminal in the public switched telephone network (PSTN). Basically, the destination for calls is the DCO switch 22 (see col. 4, line 19) from which calls are processed by a personal computer, e.g. computer 32, for a determination of whether or not the call will be allowed to continue to completion, as through the DCO switch 22 (see col. 7, line 36).

In the context of the above discussion, it is important to realize that in accordance with the '636 Patent, calls placed from an originating phone are completed to the switching station 16 for processing after which a call may either be allowed or blocked (disallowed). In that regard, claim 1 of the '636 Patent simply specifies a system for blocking calls. As specifically recited in the sixth element of the claim, the function is that *"of disallowing completion of a call through the switching station ---."*

In summary, the system of the '636 Patent operates in the same manner as Applicant's system with regard to the conditional completion of a dial-up call based on call data (ANI and identification) to determine if the caller is in good standing. If so the call will not be disallowed, though it may be interrupted. In the final analysis, the claim language is clear and explicit. The defined structures are not limited to facilitating calls supported by a telephone calling card. Rather, the claims specify a system for facilitating calls based on certain input data including a parameter related to a card. Select calls are disallowed completion. The claim language does not recite anything more beyond that.

The nature of the card (or ticket) and the functional application of the system are irrelevant in view of the claim elements. As discussed in greater detail below, the preamble refers to an exemplary form of a system, i.e., a “*type*” of system, and merely states a general use, i.e., a document information processing system. Accordingly, claim 29 herein (equating to claim 1 of the ‘636 Patent) is well-supported by Applicant’s specification. This support is treated in further detail below with respect to points raised in the most recent Office Action.

Comments in the Office Action are addressed below, first by analyzing a general statement. Paraphrasing the Office Action (pg. 3, paragraph 1), the ‘636 system (a) **allows communication (b) between two telephone terminals (c) using card data (d) to control (e) a connection.**

(a) **“Allows Communication”**

The system defined by claim 29 herein (‘636 claim 1) does not explicitly recite the allowance of continued communication. Rather, the claim explicitly recites a capability “*of disallowing completion of a call*”.

Both the Applicant’s system, and the system of the ‘636 Patent involve an initial phase of communication with a switching facility and processing capability to determine whether or not completion of the call will be disallowed. The operation simply is to allow the completion of the call without specific regard to the function of the call. As stated in the ‘636 Patent, completion of a call may involve a number of different functions (see col. 3, lines 24-27 and col. 5, lines 18-21). As previously pointed out, Applicant’s system also discloses qualification, i.e., disallowing completion of calls (see Specification pg. 10, line 24; pg. 19, lines 27-34; pg. 25, line 23; pg. 26, line 3; pg. 42, line 12; pg. 43, line 11).

(b) **“Between Two Telephone Terminals”**

Neither claim 1 of the ‘636 Patent nor claim 29 herein recite communication between two telephone terminals. Neither claim recites a receiving or second terminal. Furthermore, as indicated above, the ‘636 Patent does not even illustrate a receiving terminal. Again, in accordance with the claim, the criteria involves “*completion of a call.*” The function of a completed call is irrelevant! It could well be to participate in a lottery.

Another consideration may involve the phase or stage in which a call may be disallowed completion. Clearly, the claims are totally silent on such criteria. Rather, the claimed criteria is merely whether or not the call is disallowed completion. The phase of the call in which the disallowance occurs is irrelevant. Also, the state of connections is unstated.

(c) **“Using Card Data”**

The recitation involves the “*data*” mentioned in the introduction as related to cards. Note that claim 1 of the ‘636 Patent specifies “*travel cards*”, however, in the Specification, the cards function simply as credit cards (see col. 5, line 5; col. 6, line 42; etc.). Basically, the question is whether or not the adjective “*travel*” or the term “*cards*” are limitations or are of no significance to the claim. In that regard, reference is made to the Manual of Patent Examination Procedure (MPEP), specifically 2111.02 under the subtitle “*PREAMBLE STATEMENTS RECITING PURPOSE OR INTENDED USE*”.

Explicitly, the preamble of the ‘636 Patent, claim 1, recites a “*telephone system - -- of a type controllable by data related to travel cards*”. However, the claim is not directed to travel cards. The claim is not directed to a system that is confined to processing data from “*travel cards.*” Rather, under the authorities for claim interpretation, the claim is directed to a

system of a type controllable by data related to cards. In accordance with the MPEP, if the preamble “*merely states, for example, the purpose or intended use of the invention ---, “---then the preamble is not considered a limitation and is of no significance to claim construction.*”

The case law is completely consistent with the MPEP, for example: “*a preamble is not limiting where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention.*” A&E Products Group, L.P. v. Mainetti USA Inc., et al., 2002 USC, Lexis 24280, citing Rowe, 112 F. 3d 473, 478 (Fed. Cir. 1997). Such is precisely the situation here! The words “*travel*” and “*card*” are merely exemplary of an intended use of the invention. Accordingly, the words “*travel*” and “*card*” are not significant to the breadth of the claim.

Perhaps another consideration relates to the use of the expression “*data related to cards*”. As briefed in prior arguments, Applicant’s system clearly discloses the use of data from cards for processing, specifically in the form of credit cards, e.g. see Applicant’s Specification pg. 12, line 1; also pg. 21, line 34 and following. In summary, the ‘636 Patent claims a system for use in association with credit card data. Applicant’s disclosure is addressed to the same system.

(d) “To Control”

A few considerations are pertinent with respect to the language “*to control*”. First, the language of the claims (Marshall’s 1 and Applicant’s 27), is explicit on the nature of the “*control*.” Specifically, the control involves, “*disallowing completion*” and “*interrupting*”. Otherwise, the claims are not specific with regard, either to the stage at which such control is exercised, to the nature of the elements involved in the dial-up communication at the time control

is exercised or to the ultimate function to be accomplished as a result of the dial-up communication.

In the disclosures of both Marshall and Applicant, dial-up communication is accomplished, preliminarily with a processing capability, whereby control may involve “*disallowing completion*” or “*interrupting*” a call. The claims state as such, both, Marshall’s claim 1 and Applicant’s claim 29. Accordingly, Applicant’s claim 29 is fully supported by the disclosure.

(e) “A Connection”

Applicant’s claim 29 is totally silent on any of: the nature of the connection, the recipient structure of the connection, or the ultimate object of the connection. The intended purpose of the call is totally irrelevant within the scope of Marshall’s Claim 1. In interpreting the claim, it is irrelevant whether the connection is: to re-route a call, to address a voice response device, to complete a dialed call (see Marshall, col. 3, lines 24-27), or for that matter, to address a lottery operation or couple to an interface terminal (Applicant’s Specification). The definitive requirement of the claim resides solely in “*disallowing completion of a call,*” which (by implication), otherwise would be permitted completion.

Thus, it is apparent that Applicant’s specification supports claim 29 in each of the recited elements. Similarly, claims 29, 33, 35-39, 43, and 45-48 are supported in that the claims recite using: “*call data,*” “*processed data,*” and “*data --- related to a card,*” to determine “*good standing,*” (i.e., qualification) and then, if appropriate, “*disallowing completion of a call.*”

Claims 38 and 48 are void of further limitations as to the call passing “to” any specific terminal or component. The claims simply specify disallowance of completion. Applicant’s system does so in the “*qualification*” phase.

Returning to a general consideration of the rejections, a key issue relates to one of the operations of the Marshall Patent (‘636), which involves completing a call through the PSTN to a “*second party*.” However, Marshall’s operation is not so limited. Specifically, in addition to completing a call by a travel card user, the ‘636 Patent system may “*re-route the call*” (col. 3, line 25). Accordingly, consider an exemplary implementation of the ‘636 Patent system, which operates simply to re-route calls, however, which incorporates all the claim elements. That is, the exemplary system has a “*switching system*” etc., and functions to obtain ANI, and PIN data etc., along with card data, all for selectively “*disallowing*” etc. In such an exemplary system, note that the ‘636 Patent does not disclose any terminal for a second party called through the PSTN. As for the PSTN, the ‘636 Patent simply discloses conventional components, e.g., a Digital Central Office (DCO 22, col. 7, lines 39-41) of the PSTN. However, again, calls may be continued to other designated possibilities, e.g., a voice response unit (col. 3, lines 23-29). In view of such disclosure, and the claim wording consider a question: would the exemplary system, as specified above, fall within the claims? It is contended that they would, and if the claims are so interpreted, Applicant’s specification supports them.

A related comment involves the phases of telephone connection. That is, the claims do not specify one connection for processing and a second connection to a “*second party*.” Specifically, claim 29 simply recites, “*receiving call data from at least one dial-up communication source followed by, “disallowing completion of a call through the switching station.”*” The call is received through the “*switching station*” (16) and continues to pass through

the switching station, whether it goes to a second party, to a voice response unit or to any designation. Completion of a call may simply constitute allowing a call to conclude in a transaction. The nature of the call or the transaction involved is not specified and thus is not relevant. Such operation is covered by the claims and is fully supported by Applicant's specification.

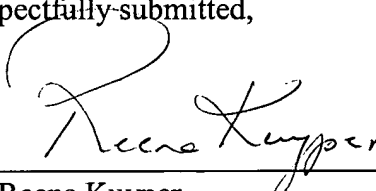
Applicant's specification supports claim 29 in each of the recited elements. Similarly, claims 33, 35-39, 43, and 45-48 are supported in that the claims recite obtaining: "*call data*," "*processed data*," and "*data ---- related to a card*," to determine "*good standing*," (i.e., qualification) and then, if appropriate, "*disallowing completion of a call*."

Claims 38 and 48 also are void of limitations as to the call passing "*to*" any specific terminal or component. The claims simply specify disallowance of completion, or preventing a connection generally. Applicant's system does so in the "*qualification*" phase.

In view of the above aspects, reconsideration of this application and the claims pending here is again respectfully requested.

Respectfully-submitted,

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By: 
Reena Kuyper
Registration No. 33,830

9220 Sunset Blvd., Suite 315
Los Angeles, CA 90069
(310) 247-8191